

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/735,696 Confirmation No. : 8984
First Named Inventor : Michael Man-Hak TSO
Filed : December 16, 2003
TC/A.U. : 2616
Examiner : HAILE, AWET A
Docket No. : 101610.55983US
Title : Stateless Message Routing

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully submit that the Office Action issued on January 22, 2009, was made final prematurely, and accordingly, the finality of this Office Action should be withdrawn.

Regarding the propriety of final rejections on a second or subsequent action on the merits, M.P.E.P. § 706.07(a) states that such actions:

shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is respectfully submitted that the new grounds of rejection in the final Office Action issued on January 22, 2009, was not necessitated by Applicants' amendment and was not based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c). Instead, based on the reasoning provided in the Office Action, it appears that the

new grounds of rejection could have been made regardless of Applicants' amendments.¹

The Office Action issued on June 12, 2008, only included rejections for anticipation under 35 U.S.C. § 102 and for obviousness under 35 U.S.C. § 103(a).

Applicants' Reply filed on October 8, 2008, amended independent claim 23 as follows:

23. (Currently Amended) A method of processing messages comprising:

storing historical data for one or more destination hosts;

receiving control data;

receiving a message over a first connection, the message being associated with the one or more destination hosts;

determining whether to employ that stateless routing of the message is to be employed based on the historical data and the control data;

storing the message only in volatile memory and withholding confirmation of receipt of the message if it is determined that stateless routing is to be employed;

sending the message to the one or more destination hosts over additional connections forming one or more virtual circuits;

receiving confirmation of delivery from one or more destination hosts associated with the message; and

sending the confirmation of receipt to a sender of the message.

The final Office Action issued on January 22, 2009, *added* the new rejection of claim 23 for being directed to non-statutory subject matter. The basis for this rejection is that claim 23 recites "purely mental steps...without

¹ The discussion that follows is not an acquiescence that this is a proper ground of rejection (which it is not), but merely a discussion based on whether, in view of the reasoning provided in the Office Action, the new grounds of rejection was necessitated by Applicants' amendments.

tying the steps to one of the four statutory categories of invention recited in U.S.C. § 101."

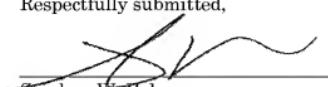
The amendments to claim 23 did not change the claim in a manner such that the reasoning to support this rejection would have arisen in response to this amendment. In other words, under the reasoning provided in the Office Action this rejection would have been proper regardless of whether this amendment was made. Thus, this amendment did not *necessitate* the rejection under 35 U.S.C. § 101.

Because the new ground of rejection in the final Office Action issued on January 22, 2009, is not necessitated by Applicants amendments of the claims and is not based on information cited by the Applicants in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c), it is respectfully submitted that the finality of this Office Action is improper and should be withdrawn.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #101610.55983US).

Respectfully submitted,

January 28, 2009



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